

REMARKS

By this Amendment, Applicants amend claims 1, 3, 5, 6, 15, 18, and 19 to more appropriately define the present invention. Upon entry of this Amendment, claims 1, 3, 5, 6, and 15-23 remain pending.

In the Final Office Action, the Examiner maintained the rejection of claims 1, 15, 16, 18, 20, and 22 under 35 U.S.C. § 103(a) as unpatentable over Wactlar et al., U.S. Patent No. 5,835,667 ("Wactlar") in view of Kazami et al., U.S. Patent No. 6,035,093 ("Kazami"); maintained the rejection of claims 3, 17, 19, 21, and 23 under 35 U.S.C. § 103(a) as unpatentable over Maruyama et al., U.S. Patent No. 6,453,119 ("Maruyama") in view of Kazami; and rejected claims 5 and 6 under 35 U.S.C. § 103(a) as unpatentable over Maruyama in view of Kim et al., U.S. Patent No. 6,519,415 ("Kim").

I. Regarding the Drawings

The Examiner approved the Request for Approval of Drawing Change filed on June 3, 2003. Applicants submit herewith one (1) replacement drawing sheet including the approved change.

II. Response to 35 U.S.C. § 103(a) rejection over Wactlar in view of Kazami

The Examiner rejected claims 1, 15, 16, 18, 20, and 22 under section 103(a) as unpatentable over Wactlar in view of Kazami. In response, Applicants submit that a *prima facie* case of obviousness has not been established for claims 1, 15, 16, 18, 20, and 22 because Wactlar and Kazami fail to teach or suggest all the elements of these claims.

In order to establish a *prima facie* case of obviousness, three basic criteria must be met. First, the prior art reference (or references when combined) must teach or suggest all the claim elements. Furthermore, "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art." M.P.E.P. § 2143.03, ed. 8, rev. 1 (Feb. 2003) (quoting *In re Wilson*, 424 F.2d 1382, 1385 (C.C.P.A. 1970)). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a

reference or to combine reference teachings. Third, there must be a reasonable expectation of success.

M.P.E.P. § 2143 at 2100-122 to 127.

Claim 1 is directed to a information storage medium for recording audio information and still image information comprising a combination of elements including, *inter alia*, “set information for setting one or more pieces of … still image information to represent contents of … music reproduction unit, wherein said set information is provided for at least one of said music reproduction units, and a specific one of the pieces of the still image information configured to be displayed first in the music reproduction unit is set as a representative still image of the contents of the music reproduction unit.”

Wactlar is directed to creating a searchable digital library for text, audio, and video segments.

Wactlar, col. 4, lines 31-32. In order to assist with searching, Wactlar’s digital library includes a “function 35” that generates icons for a particular segment of video. Wactlar, col. 13, lines 52-53. However, the icon is merely a frame of the video and does not represent the contents of a music reproduction unit. Wactlar, col. 13, ll. 53-68. Thus, Wactlar does not teach or suggest at least “set information is provided for at least one of said music reproduction units, and a specific one of the pieces of the still image information configured to be displayed first in the music reproduction unit is set as a representative still image of the contents of the music reproduction unit,” as recited in claim 1.

Moreover, Kazami also fails to teach or suggest at least this claim element. Kazami is directed to an image file editing system and method. In Kazami, an image file editing system reads out the leading image from a selected image file. Kazami, col. 1, lines 55-61. However, Kazami’s leading image does not represent the contents of a music reproduction unit. Thus, Kazami does not teach or suggest at least “set information is provided for at least one of said music reproduction units, and a specific one of the pieces of the still image information configured to be displayed first in the music

reproduction unit is set as a representative still image of the contents of the music reproduction unit,” as recited in claim 1.

Therefore, Wactlar and Kazami, whether taken alone or in combination, fail to teach or suggest all the elements of claim 1. Accordingly, a *prima facie* case of obviousness has not been established for claim 1. For at least this reason, the rejection of claim 1 under section 103(a) is improper and should be withdrawn.

Claim 16 is directed to a method for reproducing the audio information and the still image information from the medium of claim 1. Claim 18 is directed to a method for recording management information with respect to the still image information of the representative still image on the medium of claim 1. Claim 20 is directed to an apparatus for reproducing the audio information and the still image information from the medium of claim 1. Claim 22 is directed to an apparatus for recording the audio information and the still image information on the medium of claim 1.

As mentioned above, Wactlar and Kazami, whether taken alone or in combination, do not teach or suggest at least “set information is provided for at least one of said music reproduction units, and a specific one of the pieces of the still image information configured to be displayed first in the music reproduction unit is set as a representative still image of the contents of the music reproduction unit,” as recited in claim 1. Since Wactlar and Kazami fail to teach or suggest at least a medium comprising the elements of claim 1, Wactlar and Kazami, also fail to teach or suggest at least methods and an apparatus for recording and reproducing information on the medium of claim 1. Accordingly, a *prima facie* case of obviousness has not been established for claims 16, 18, 20, and 22 which depend from claim 1. For at least this reason, the rejection of claims 16, 18, 20, and 22 under section 103(a) is improper and should be withdrawn.

Claim 15 is directed to a method for reproducing music information from an information storage medium which records audio information associated with a representative image, one or more pieces of still image information including the representative image, and management information including program chain information indicating a sequence of reproduction of the audio information, wherein a specific one of the pieces of the still image information configured to be displayed first in a unit of music reproduction is being set as the representative image comprising a combination of elements including, *inter alia*, “reproducing said program chain information to search for the representative image.”

As mentioned above, Wactlar and Kazami do not disclose at least still image information being set as the representative image of a music reproduction unit. Since Wactlar and Kazami do not disclose still image information being set as the representative image of a music reproduction unit, Wactlar and Kazami also fail to teach or suggest at least “reproducing said program chain information to search for the representative image.” Thus, Wactlar and Kazami, whether taken alone or in combination, fail to teach or suggest all the elements of claim 15. Accordingly, a *prima facie* case of obviousness has not been established for claim 15. For at least this reason, the rejection of claim 15 under section 103(a) is improper and should be withdrawn.

III. Response to 35 U.S.C. § 103(a) rejection over Maruyama in view of Kazami

The Examiner rejected claims 3, 17, 19, 21, and 23 under section 103(a) as unpatentable over Maruyama in view of Kazami. In response, Applicants submit that a *prima facie* case of obviousness has not been established for claims 3, 17, 19, 21, and 23 because Maruyama and Kazami fail to teach or suggest all the elements of these claims.

Claim 3 is directed to an information storage medium for recording audio information, still image information, and management information including one or more reproduction sequences for reproducing said audio information, wherein, in at least one of said reproduction sequences, said still

image information is configured to be displayed at the same time when said audio information is reproduced comprising a combination of elements including, *inter alia*, “wherein, in a case where the still image information is configured to be displayed at the same time when the audio information is reproduced in accordance with the reproduction sequence, a specific one of the pieces of the still image information configured to be displayed first is set as a representative still image of the contents of the reproduction sequence.”

Maruyama teaches a digital recording/playback system for DVD disks. Maruyama, col. 4, lines 50-51. In addition, Maruyama teaches storing still pictures such as stills and slides. Maruyama, col. 8, lines 14-18. Maruyama also teaches storing menu information for the video data on the disks. However, Maruyama fails to disclose still image information being set as the representative image of a sequence of audio data. Thus, Maruyama fails to teach or suggest at least “in a case where the still image information is configured to be displayed at the same time when the audio information is reproduced in accordance with the reproduction sequence, a specific one of the pieces of the still image information configured to be displayed first is set as a representative still image of the contents of the reproduction sequence,” as recited in claim 3.

Moreover, Kazami also fails to teach or suggest at least this claim element. Kazami is directed to an image file editing system and method. In Kazami, an image file editing system reads out the leading image from a selected image file. Kazami, col. 1, lines 55-61. However, Kazami's leading image does not represent a sequence of audio data. Thus, Kazami does not teach or suggest at least “in a case where the still image information is configured to be displayed at the same time when the audio information is reproduced in accordance with the reproduction sequence, a specific one of the pieces of the still image information configured to be displayed first is set as a representative still image of the contents of the reproduction sequence,” as recited in claim 3.

Therefore, Maruyama and Kazami, whether taken alone or in combination, fail to teach or suggest all the elements of claim 3. Accordingly, a *prima facie* case of obviousness has not been established for claim 3. For at least this reason, the rejection of claim 3 under section 103(a) is improper and should be withdrawn.

Claim 17 is directed to a method for reproducing the audio information and the still image information from the medium of claim 3. Claim 19 is directed to a method for recording the management information with respect to the still image information of the representative still image on the medium of claim 3. Claim 21 is directed to an apparatus for reproducing the audio information and the still image information from the medium of claim 3. Claim 23 is directed to an apparatus for recording the audio information and the still image information on the medium of claim 3.

As mentioned above, Maruyama and Kazami, whether taken alone or in combination, do not teach or suggest at least “in a case where the still image information is configured to be displayed at the same time when the audio information is reproduced in accordance with the reproduction sequence, a specific one of the pieces of the still image information configured to be displayed first is set as a representative still image of the contents of the reproduction sequence,” as recited in claim 3. Since Maruyama and Kazami fail to teach or suggest at least a medium comprising the elements of claim 3, Maruyama and Kazami, also fail to teach or suggest at least methods and an apparatus for recording and reproducing information on the medium of claim 3. Accordingly, a *prima facie* case of obviousness has not been established for claims 17, 19, 21, and 23, which depend from claim 3. For at least this reason, the rejection of claims 17, 19, 21, 23 under section 103(a) is improper and should be withdrawn.

IV. Response to 35 U.S.C. § 103(a) rejection over Maruyama in view of Kim

The Examiner rejected claims 5 and 6 under section 103(a) as unpatentable over Maruyama in view of Kim. In response, Applicants submit that that a *prima facie* case of obviousness has not been

established for claims 5 and 6 because Maruyama and Kim, taken alone or in combination, fail to teach or suggest all the elements recited in the claims.

Claim 5 is directed to a method for setting a representative image selected from one or more pieces of still image information comprising a combination of element including, *inter alia*, “recording ... a specific one piece of the still image information being coincident with the representative image of contents of said first audio information before being divided, as a representative image of contents of said second audio information and as a representative image of contents of said third audio information.” Claim 6 is directed to a method for setting a representative image selected from one or more pieces of still image information comprising a combination of element including, *inter alia*, “recording ... the representative image of contents of earlier-reproduced audio information, as a representative image of contents of said sixth audio information, wherein said earlier-reproduced audio information indicates one of said fourth audio information before combining and said fifth audio information before combining, which one is reproduced earlier than the other after being combined.”

In the rejection of claims 5 and 6, the Examiner alleged that Maruyama teaches all the elements of the claimed invention, but admitted it failed to teach “the display of multiple pictures during a single audio playback event.” (OA at 10-14.) The Examiner alleged that Kim teaches the plurality of pictures being displayed with the playing of an audio recording. (OA at 10-14.) Contrary to the Examiner’s allegations, Maruyama and Kim fail to teach or suggest all the elements recited in the claims.

Maruyama teaches a DVD hierarchical structure which may include menus to indicate different parts of data stored on the DVD. Maruyama, Fig. 3. However, Maruyama fails to disclose recording representative images of the contents of different audio information. Therefore, Maruyama does not teach or suggest at least “recording ... a specific one piece of the still image information being coincident with the representative image of contents of said first audio information before being divided,

as a representative image of contents of said second audio information and as a representative image of contents of said third audio information,” as recited by claim 5 and “recording ... the representative image of contents of earlier-reproduced audio information, as a representative image of contents of said sixth audio information, wherein said earlier-reproduced audio information indicates one of said fourth audio information before combining and said fifth audio information before combining, which one is reproduced earlier than the other after being combined,” as recited in claim 6.

Furthermore, Kim fails to cure the deficiencies of Maruyama. Kim teaches that video is divided into a plurality of parts and each part is linked with an inputted still image. See Kim, col. 3, lines 53-68. Therefore, after a video is divided, each part of the video is assigned its own still image. Therefore, Kim also does not teach or suggest at least “recording ... a specific one piece of the still image information being coincident with the representative image of contents of said first audio information before being divided, as a representative image of contents of said second audio information and as a representative image of contents of said third audio information,” as recited by claim 5 and “recording ... the representative image of contents of earlier-reproduced audio information, as a representative image of contents of said sixth audio information, wherein said earlier-reproduced audio information indicates one of said fourth audio information before combining and said fifth audio information before combining, which one is reproduced earlier than the other after being combined,” as recited in claim 6.

Thus, Maruyama and Kim, whether taken alone or in combination, fail to teach or suggest all the elements recited in claims 5 and 6. Accordingly, a *prima facie* case of obviousness has not been established for claims 5 and 6. For at least this reason, the rejection of claims 5 and 6 under section 103(a) is improper and should be withdrawn..

V. Conclusion

In view of the foregoing, Applicants submit that this claimed invention is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore

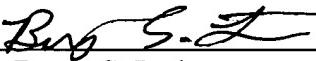
request the entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: April 13, 2004

By: 
Bryan S. Latham
Reg. No. 49,085